APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,910	09/21/2000	Anna Maria Zara	10002185-1	7529

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Intellectual Property Administration
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EXAMINER
BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 09/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>03</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>03 July 2003</u> .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)   4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   5)☐ Notice of Informal Patent Application (PTO-152)

3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .   6)☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 16 and 18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As per claim 16, the following new matter was introduced into the claim: "a server engine".

As per claim 18, the following new matter was introduced into the claim: "further configured with a cache for holding frequently accessed information".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 16, it is confusing, because it appears to describe a method steps while reffering to a system.

Also, as per claim 16, it is confusing, because it is not clear what method steps does the term "determines" contemplate.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Phaal (US 6,055,564) in view of Degenaro et al. (US 6,341,369).

Phaal teaches a method and apparatus for admission control where priority

indicator is used to discriminate between messages, comprising:

As per claims 1, 9, 14, 16 and 18-19,

- receiving an access request in the application system from the server system,

wherein the access request is requesting the application system to perform an

externally requested transaction and to generate a response for the request (Abstract;

column 2, lines 25-42; column 4, lines 45 through column 5, line 16);

- generating a tag containing the classification information (Abstract; column 2,

lines 27-57);

- sending the tag to a requesting client that issued the request such that the tag

is attached to subsequent external requests to the data service system for the same

transaction (column 2, lines 27-57; column 8, lines 30-34);

- scheduling requests to be serviced by the server system based on the

classification information contained in the tag of each of the subsequent external

requests (column 2, lines 27-57; column 3, line 64 through column 4, line 3).

However, Phaal does not specifically teach storing business rules regarding classification of various transactions, and using the business rules to obtain the classification information of the transactions.

Degenaro et al. teach a method and apparatus for specifying and applying rules to classification-based decision points in an application system, wherein a set of business rules regarding classification of various transactions is used to obtain the classification information of the transaction (Abstract; column 3, lines 58-63).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Phaal to include use of a set of business rules regarding classification of various transactions to obtain the classification information of the transaction, because it would make the system more versatile, thereby make it more attractive for the customers.

As per claim 2, Degenaro et al. teach said method and apparatus wherein the tag generator causes the business rule engine to analyze the response with the business rules stored in the business rule engine to determine classification of the transaction such that subsequent requests that are part of the same transaction do not need to be classified again (Abstract; column 3, lines 58-63; column 5, line 14 through column 7, line 57).

As per claims 3 and 11, Degenaro et al. teach said method and apparatus wherein the tag generator causes the business rule engine to re-applie the business rules to responses for the subsequent requests to determine if reclassification is needed

for the subsequent requests (Abstract; column 3, lines 58-63; column 5, line 14 through

column 7, line 57).

As per claims 4, 12 and 17, Phaal teaches said method and apparatus wherein

the tag is updated if the tag generator determines that reclassification is needed

(column 2, lines 57-67).

As per claims 5 and 13, Phaal teaches said method and apparatus wherein the

server system attaches the tag into the response by placing the tag (1) in a cookie, (2)

in the body of the response message, or (3) in a URL of the response (column 10, lines

16-35).

As per claims 6 and 10, Phaal teaches said method and apparatus wherein the

step of scheduling requests further comprises parsing each of the requests to determine

if the request is for an existing transaction or for a new transaction; and if the request is

for a new transaction, assigning a default tag to the request (column 2, lines 15-16, 58-

67).

As per claim 7, Phaal teaches said method and apparatus wherein the server

system is a TCP/IP-based server application system (column 1, lines 17-33).

As per claim 8, Phaal teaches said method and apparatus wherein the server

system is one of a web server system, an e-mail server system, a news server system,

an e-commerce server system, a proxy server system, a domain name server system,

and a local service server system (column 4, lines 52-54).

As per claim 15, Phaal teaches said method and apparatus wherein the

application system is connected to the server system via a gateway interface or via a

plug-in application (column 5, line 60 – column 6, line 59;column 7, line 20 – column 8, line 66).

Response to Arguments

Applicant's arguments filed 07/03/03 have been fully considered but they are not persuasive.

In response to applicant's argument that Phaal can not be used as a prior art under 35 USC 103 (C), examiner points out that, effective November 29, 1999, in order to preclude patentability under 35 USC 103 (C), the subject matter and the claimed invention should have been a subject to an obligation of assignment to the same person at the time the claimed invention was made (MPEP, 706.02(k)). In this case, the rights for the claimed invention were not assigned to Hewlett-Packard Company on the date of invention, which is the filling date of the application (See attached: Patent Assignment Abstract or Title).

In response to applicant's argument that Degenaro et al. do not disclose the use of business rules for determining claissificaiton, examiner stipulates that Degenaro et al. teach said method and apparatus, wherein a set of business rules regarding classification of various transactions is used to obtain the classification information of the transaction (See: Abstract; column 3, lines 58-63, and discussion above).

In response to applicant's argument that Degenaro et al. do not disclose classification of customer requests, Examiner stipulates that Degenaro et al. teach a method and apparatus for specifying and applying rules to classification-based decision points in an application system, wherein a set of business rules regarding classification

of various transactions is used to obtain the classification information of the transaction (Abstract; column 3, lines 58-63; column 5, line 14 through column 7, line 57). The only differences found here are in the nonfunctional descriptive material and are not functionally involved in the steps recited.

Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry,* 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); (MPEP 2106).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to:

(703) 305-7687   [Official communications; including

After Final communications labeled
"Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal

Drive, Arlington, VA, 7th floor receptionist.

JOHN G. WEISS
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TECHNOLOGY CENTER 3600